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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|------------------------------------|------------------|
| 10/646,138 | 08/22/2003 | Frank Dean | MSH 00257 | 8942 |
| 8131 | 7590 | 01/11/2006 | | |
| MCKELLAR IP LAW, PLLC 784 SOUTH POSEYVILLE ROAD MIDLAND, MI 48640 | | | EXAMINER LARSON, JUSTIN MATTHEW | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3727 | |
| DATE MAILED: 01/11/2006 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

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|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/646,138 | DEAN, FRANK | |
| | Examiner | Art Unit | |
| | Justin M. Larson | 3727 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is made FINAL as Examiner is maintaining the original rejections set forth in the first Office Action.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Slifka (5,207,361) in view of Brown (6,698,635).

Regarding claims 1-3 and 10, Slifka teaches a golf bag carrier for a motorcycle that uses a support base (4), mounted at the rear foot peg, and straps (10 and 18) that secure the golf bag to the motorcycle frame rather than an elongated mounting frame that is secured to the motorcycle by bolts and has two U-shaped support members to hold the golf bag in place.

Brown, however, teaches a golf bag attachment for motorcycles comprising an elongated mounting frame (2, 4, 40, and 42), two U-shaped support members (8 and 10) spaced apart and extending laterally from the mounting frame member, and a plurality of passageways through the mounting frame member as seen in Figure 3, through which a fastening means secures the golf bag-holding frame to the frame of the motorcycle, utilizing the threaded saddlebag mounting brackets as seen in Figures 1 and 2.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Slifka by using a more rigid and sturdy support rack, as taught by Brown, and modifying Brown's support brackets (2 and 4) in such a way as to allow the carrier to be attached to the motorcycle's saddlebag brackets, in order to more securely fasten the golf bag and further limit the golf bag's ability to shift along the side of the motorcycle while the motorcycle is in motion which may throw off the rider's balance and place him/her in danger.

Regarding the amendment to claim 1, the claim now states that the top of the golf bag is carried in a rearward reclining position. This statement is functional language that fails to introduce any new structural limitations of the carrier into the claim that might read over the proposed combination of Slifka in view of Brown. The carrier of Slifka in view of Brown is capable of being attached to the motorcycle such that the top of a golf bag held therein would be carried in a rearward reclining position, as the carrier itself is capable of being attached to the motorcycle in a rearward reclining position.

Regarding claim 3, Official Notice is take that it is old in the art and commonly known to use threaded bolts when securing a rack or carrier to a supporting surface and that a person of ordinary skill in the art at the time the invention was made would therefore have known to use threaded bolts to attach the golf bag carrier to the motorcycle frame in order to provide a secure and dependable attachment.

Regarding claims 4-9 and 11, even though Slifka in view of Brown fails to define an angle or range of angles that would be formed between the U-shaped support members aligned with the foot pegs and the longitudinal axis of the motorcycle, it would

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have been obvious to one having ordinary skill in the art at the time the invention was made to determine the appropriate angle based on the weight and dimensions of the carrier and/or the golf bag itself in order to maintain an appropriate center of gravity for the motorcycle/carrier assembly, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Response to Amendment

4. The original objection to the disclosure with regard to the trademark Ghost Brackets has been withdrawn in view of the amended page 5.

Response to Arguments

5. Applicant's arguments filed October 31st, 2005 have been fully considered but they are not persuasive.

Applicant has asserted that "Slifka does not teach a golf bag carrier for use on a motorcycle." Examiner would like to point out that Slifka begins his abstract with "A golf bag carrier for a motorcycle which is designed for easy attachment and detachment."

Applicant has also asserted that the mounting of the golf bag is vertical, causing problems with wind resistance and center of gravity. Examiner agrees that a vertical orientation vs. an angled orientation will have different effects on these areas for concern, however, there is no existing structure in claims 1-3 and 10 that would require the carrier is mounted at an angle. While claims 4-9 and 11 address this angle, Examiner directs Applicant's attention to the art of record.

Particularly, Schurr (US 6,619,522) teaches that a golf bag carrier for a motorcycle may be inclined forwardly or rearwardly (col. 5 lines 16-20). Adams (US 2003/0209581) teaches a carrier for a motorcycle that is also rearwardly angled. Finally, James (6,938,806) teaches a golf bag carrier for a motorcycle that is angled inwardly. Applicant has asserted that it would not have been obvious to determine an appropriate angle for mounting. Clearly, it is known in the art to angle such carriers when they are attached to a motorcycle, and Examiner maintains the position that it would be obvious to one having ordinary skill in the art to determine the proper mounting angle required in such situations.

Furthermore, the modified golf bag carrier of Slifka in view of Brown is to be mounted on the motorcycle's foot peg as disclosed by Slifka. Slifka does not specifically state whether or not the carrier has to be mounted on the front or rear foot peg in order to function, and although the carrier is shown mounted to the rear foot peg in Figure 2, the carrier base comprises a round mounting member (15, Figure 3) that would allow a user to mount the carrier to any round foot peg at any angle. One of ordinary skill might decide to mount the carrier to a front foot peg, as maybe their motorcycle did not have a rear foot peg, the front foot peg generally located much closer to the front of the motorcycle than the fender mounting points. In order to attach the carrier, it would have to be attached to the front foot peg and then angled rearwardly so as to align with the fender mounting points for securement of the carrier frame to the fender.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that

any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin M. Larson whose telephone number is (571) 272-8649. The examiner can normally be reached on Monday - Friday, 8am - 4pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan J. Newhouse can be reached on (571) 272-4544. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JML
1/5/06



NATHAN J. NEWHOUSE
SUPERVISORY PATENT EXAMINER